

REMARKS

Reconsideration of claims 1, 3, 6, 10, 12, 15, 19, 24-27 and 30-34, and new claims 35-38 is respectfully requested. Claim 10 as amended and new claim 35 includes a selected weight percent range directed to the one or more poloxamer or poloxamine surfactants with a HLB value of less than 12. Support for the recited weight percent range in amended claim 10 can be located on page 7, paragraph [0015] and Test Solutions 1 and 2 listed in Table 1 on page 16. New claims 36-38 are supported by the concentrations of Pluronic®P123 (HLB of 8) in Test Solutions 1 and 2.

The rejection of claims 1, 3, 6, 10, 12, 15, 19, 30, 31 and 33-34 under 35 USC 103(a) as unpatentable over Howes (US 4,504,405) in view of Ogunbiyi (US 4,758,595) is respectfully traversed. The examiner asserts that "it would be obvious to combine two of the [recited] surfactants [see, list below] in the same composition because the surfactants are employed in the same way and since they are listed together as surfactants combining two of the surfactants would have yielded predictable results to someone of ordinary skill in the art." Applicants respectfully disagree, and submit that the examiner has not put forward a proper *prima facie* case of obviousness. The examiner has erred in at least two ways.

As commented by the Official Action on page 3 (bottom) to page 4, Howes discloses methods of cleaning soft contact lenses using an aqueous solution containing an acceptable non-ionic surfactant such as poly(oxyethylene) stearate esters (commonly known as Myrijs), poly(oxyethylene)ethers of C₈ to C₁₈ fatty alcohols (commonly known as Brijs), sorbitan fatty acid esters (commonly known as Tweens), [and] poly(oxyethylene)-poly(oxypropylene) block copolymers (commonly known as Poloxamers or Pluronics). Col. 2, lines 48-56. Howes further recites a list of five (5) poloxamers one of which is Pluronic L62, which has a HLB of 7. The remaining four (4) in the list have an HLB value of 15 or greater. Moreover, Howes teaches that Pluronic L64 (HLB of 15) is the preferred poloxamer to be used in the solutions.

Provided with this teaching as a whole, the rejection, for reasons unknown and not yet explained, first must pick the class of Pluronics (poloxamers) from the others, i.e., Myrijs, Brijs and Tweens, and second pick Pluronics L62 from the five Pluronics

specifically recited to meet Applicants' selection of a "poloxamer and poloxamine having a HLB value of less than 12", and third, then combine the Pluronics L62 with one other Pluronic, but not Pluronic L64 as this has a HLB of 15 – not greater than 18), nor a surfactant from any of the other recited class of surfactants. The rejection asserts that each of these selections would be obvious to one of ordinary skill from the knowledge gained from Howes, and therefore, Applicants' claimed combination of surfactants is obvious. This is error based on hindsight. There can be no other explanation.

If anything, Howes preferred choice of Pluronic surfactant directs one to Pluronics L64, which teaches away from the Applicants' claimed combination of HLB values. Moreover, Applicants submit that the examiner's proposed combination would not have "yielded predictable results to someone of ordinary skill in the art." The rejection improperly cites to Howes as identifying each of the claimed recitations and then combines each of the individual reference teachings to reconstruct Applicants' claimed compositions. Applicants submit that it is improper for the Examiner to reconstruct the claims without a hint of suggestion or motivation in the art to combine those teachings as taught by the Applicants own patent application. This reconstruction is improper even though each of Howes list of Pluronic surfactants are known components of contact lens solutions. As stated recently by the Court in *KSR International Co. v. Teleflex Inc.*, ___ U.S. ___ (April 30, 2006)

"a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices [elements] according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

[Although, t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion and motivation ... [(TSM), t]here is no necessary inconsistency between the idea underlying the TSM test and the *Graham* analysis."

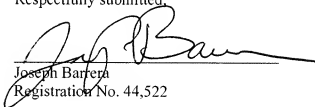
Applicants respectfully submit that the citation to Ogunbiyi does not overcome the stated deficiencies in Howes, and accordingly, request that the rejection be withdrawn.

In addition, for the reasons stated, Applicants respectfully request that the rejection of claims 1, 3, 6, 10, 12, 15, 19, 24, 25, 30, 31 and 33-34 under 35 USC 103(a) as unpatentable over Howes in view of Ogunbiyi and Vehige be withdrawn.

Applicants submit a one month extension of time with this Amendment. Please charge any fee or credit overpayment to Deposit Account No. 02-1425.

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Respectfully submitted,



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